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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92051860
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

LA MONTRE HERMES S.A.,

Petitioner,

v.

MICHAEL AKKAWI,

Registrant.

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BOX TTAB

CANCELLATION NO.
92-051860
(Reg. No. 3,433,601)

BRIEF FOR PETITIONER

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I. INTRODUCTION AND STATEMENT OF ISSUES

Petitioner La Montre Hermes (“Petitioner” or LMH) owns U.S. Registration No. 2,753,802 for the trademark CAPE COD 2 ZONES for watches (“Petitioner’s Registration”). Respondent owns Registration No. 3,433,601 for the mark CAPE COD WATCH for “clocks and watches; jewelry and watches; jewelry clocks and watches; jewelry watches, watch bracelets” (“Respondent’s Goods”). Respondent’s Registration should be cancelled because (1) Respondent’s mark is confusingly similar to Petitioner’s Mark and is applied to identical and closely related goods; and (2) Respondent has never used its mark in interstate commerce on any goods. Further, because Respondent has never used its mark on “jewelry”, “clocks” or “jewelry clocks,” these goods must be deleted from the registration if it somehow survives cancellation.

II. DESCRIPTION OF THE RECORD

The record in this case is sparse. The relevant pleadings are the Amended Petition for Cancellation and Respondent’s Answer to the Amended Petition. The evidence of record consists only of Petitioner’s Registration and respondent’s answers to certain of petitioner’s interrogatories and requests for admissions (“RFAs”), all made of record through Petitioner’s Notice of Reliance filed on October 7, 2011.

III. STATEMENT OF FACTS

The facts as set forth in the record are as follows:

Since long prior to Respondent’s first use of CAPE COD WATCH, Petitioner has sold watches in the United States and elsewhere under the trademark CAPE COD 2 ZONES (Amended Petition, ¶¶ 1 and 4, admitted by Respondent). Petitioner’s Registration, issued on August 19, 2003, is based on an application filed on April 4, 2001. (Notice of Reliance, Ex. C). Petitioner’s Registration is incontestable under Section 15 of the Lanham Act (*id.*).

Respondent is an owner of Hannoush Jewelers of Cape Cod (“HJCC”), a franchisee of Hannoush Jewelers, Inc (Response to Interrogatory 5 and RFA 2). HJCC has two retail stores, located in Falmouth and Hyannis, MA (Responses Interrogatory 2 and RFA 3). HJCC has never operated any retail stores outside of Massachusetts (Response to RFA 17).

Respondent manufactures watches in Massachusetts and sells them bearing the mark CAPE COD WATCH only to HJCC, who then resells them only through its two Massachusetts stores as Respondent’s purported licensee. (Answer to Amended Petition, ¶ 7; Response to Interrogatory 2). Neither Respondent nor HJCC has ever sold any watches through a website (Response to Interrogatory 1 and RFAs 1, 6, 20, 21).

Respondent’s application for registration was based on use in commerce under Section 1(a) of the Lanham Act. In the application, Respondent swore that, as of the filing date of December 27, 2007, the trademark CAPE COD WATCH was in use in commerce on “jewellery [sic], clocks and watches.” In fact, Respondent has never used the mark on any goods other than watches –either before filing his application or thereafter. (Responses to RFAs 7, 8, 10, 11, 13).

IV. ARGUMENT

A. Respondent’s Registration Should be Cancelled Under Section 2(d)

Petitioner competes with Respondent in the sale of watches and owns the pleaded registration, which is valid and subsisting. Therefore, Petitioner has a personal interest in this proceeding and clearly has standing. *Top Tobacco, L.P. v. N. Atl. Operating Co., Inc.*, 101 U.S.P.Q.2d 1163 (TTAB 2011).

Petitioner’s proof of ownership of the pleaded registration, based on its application filed more than six years before the application on which respondent’s registration is based, conclusively proves petitioner’s priority. *King Candy, Inc. v. Eunice King’s Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108 (CCPA 1974).

Therefore, the only question on the Section 2(d) ground for cancellation is whether CAPE COD WATCH, for Respondent's Goods, creates a likelihood of confusion with respect to CAPE COD 2 ZONES for identical and closely related goods. This is not a close question. The marks are confusingly similar, and the registration should be cancelled on this ground alone.

The lodestar *du Pont* case¹ set forth thirteen non-exclusive factors to be weighed in determining this issue, but these factors are to be considered only to the extent there is an evidentiary basis to do so. 476 F.2d at 1361, 177 USPQ at 567; see also *In re Dixie Rest.*, 105 F.3d 1405, 1406, 41 USPQ 2d 1531, 1533 (Fed. Cir. 1997). In any likelihood of confusion analysis, the two key issues are similarities between the marks and similarities between the goods and/or services. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (CCPA 1976); *In re Sherwood Dev. Group LLC*, (Serial No. 77784128, TTAB November 11, 2011)(non-precedential); *In re Midwestern Pet Foods, Inc.*, (Serial No. 777327252, TTAB November 16, 2011)(non-precedential).

1. The Goods Are Identical

For purposes of comparison, the goods of the parties are identical. Both Petitioner's Registration and Respondent's Registration covers "watches."² This identity of goods is conclusive on the "similarity of goods" issue.

Respondent's registration also includes "clocks," "jewelry clocks" and "jewelry" (the "Non-Watch Goods"), which obviously are closely related to watches. However, Respondent

¹ *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

² Petitioner's Registration originally included watches "and their component parts, watch bands and watch clasps," but these goods were deleted when Petitioner filed its Section 8 Declaration.

admits that it has never used the mark on any goods other than watches.³ It is true that a determination under Section 2(d) must be based upon the goods recited in the respective registrations, not upon the goods as sold by the parties. *J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 U.S.P.Q.2d 1889 (Fed. Cir. 1991). However, Petitioner's admission of lack of use on the Non-Watch Goods means that the registration must be cancelled with respect to these goods, regardless of how this Board decides the Section 2(d) issue. See *infra*. Section III C.

2. The Marks Are Very Similar

In comparing the marks themselves, the test is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (BNA) (TTAB 1975). Under actual marketing conditions, consumers do not have the luxury of making side-by-side comparisons, and must rely on imperfect recollections. *Dassler KG v. Roller Derby Skate Corp.*, 206 U.S.P.Q. (BNA) 255, 259 (TTAB 1980).

“When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines,” *Century 21 Real*

³ Respondent's response to RFAs 8 and 11 self-servingly justified the inclusion of “jewelry” on the ground that “watches are a species of jewelry.” There is no basis for this contention. “Jewelry” and “watches” are separate specifications in the PTO's *Acceptable Identification of Goods and Services Manual* (“ID Manual”); There is also a specification of “jewelry **and** watches” in the ID Manual. If watches were just a species of jewelry, there would be no reason to have two separate specifications or to identify them separately in the “jewelry and watches” specification. It is absurd to contend that one who has sold only watches under a mark is entitled to a registration for watches *and* jewelry.

Estate Corp. v. Century Life of Am., 970 F.2d 874, 877 U.S.P.Q.2d 1698, 1701 (Fed. Cir. 1992). This Board applied this principle in *In re Chica Inc.*, 84 U.S.P.Q.2d 1845 (TTAB 2007), refusing registration of CORAZON BY CHICA and design for, *inter alia*, jewelry, watches and clocks due to a prior registration of CORAZON for jewelry. *See, also, In re Sherwood Development Group LLC* (affirming refusal of registration of NOURISH KIDS due to prior registration of NOURISH for partially overlapping goods).

The dominant portion of both marks is CAPE COD. The word “watch” in Respondent’s mark is plainly generic for watches, and “2 ZONES” in Registrant’s mark has a descriptive connotation with respect to a watch which shows time in two different time zones. While marks must be compared in their entireties, it is well settled that merely descriptive matter is accorded subordinate status in the analysis. *Dixie Restaurants*, 41 U.S.P.Q.2d at 1533 (THE DELTA CAFÉ confusingly similar to DELTA for overlapping services), and that “the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered....” *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988). Thus, there is nothing improper in giving more weight to the more significant features of the marks. *In re Na’l. Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985).

That principle applies in this case, where the first part of each mark is CAPE COD, and CAPE COD is the only portion of the marks that is not descriptive. Thus, consumers would likely remember CAPE COD as the brand of watch sold by both parties, making confusion highly likely.

3. No Other Factors Favor Respondent

Strength of Petitioner’s Mark -- CAPE COD has no inherent descriptive or place-association meaning with respect to watches. There is no evidence of any third-party use or registration of CAPE COD in connection with watches. Therefore, even though petitioner has

not made of record any evidence with respect to its sales or advertising under the mark, it may be concluded that the mark is conceptually strong and has not been weakened or diluted through third-party uses or registrations.

Channels of Trade – Where, as here, the goods in the respective registrations are in part identical, and where the goods in the registrations are not limited in any way with respect to channels of trade, this Board must presume that the respective channels of trade and classes of purchasers are the same. *Genesco Inc. v. Martz*, 66 U.S.P.Q.2d 1260, 1268 (TTAB 2003). Since there is no evidence to the contrary, these factors favor petitioner.

Actual Confusion – It is well settled that proof of actual confusion is not required in order to prove a likelihood of confusion. *Herbko Intern., Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 64 U.S.P.Q.2d 1375 (Fed. Cir. 2002). This is especially true where, as here, the second-comer's product has not been sold extensively. *See, e.g., Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 56 U.S.P.Q.2d 1942 (7th Cir. 2000). Therefore, this factor is neutral.

In summary, the salient factors of similarity of mark and similarity of goods strongly favor petitioner. No *duPont* factor favors respondent. The registration should therefore be cancelled under Section 2(d) of the Lanham Act.

B. Respondent's Registration Should Be Cancelled Because the Mark Was Not and Has Not Been Used in Commerce

It is fundamental that a trademark is entitled to Federal registration only if it has been used "in commerce", i.e., in commerce which may lawfully regulated by Congress. 15 U.S.C. §§1051, 1127. A registration that does not meet the use in commerce requirement is void *ab initio*. *Aycock Eng., Inc. v. Airflite, Inc.*, 560 F.3d 1350, 90 U.S.P.Q.2d 1301 (Fed. Cir. 2009).

In this case, respondent admits that its business is wholly intrastate. Respondent manufactures the goods in Massachusetts and sells them only to two retail stores in

Massachusetts. (Answer to Amended Petition, ¶ 7; Response to Interrogatory 2). Even assuming that the retail stores are “licensees” of respondent (Response to RFA 2), and that sales under the mark by these stores inure to respondent’s benefit, there is still no evidence that either store has ever made any sales under the mark except to customers who walk into the store and buy watches there. Respondent admits that neither it nor his “licensees” have ever sold any products under the mark through any website (Response to RFAs 20, 21).

Respondent may argue (without evidence) that some of his “licensee’s” customers are from out of state, and that in-store sales to these out-of-state customers constitutes use in interstate commerce. But that is not the law. “[T]he fact that purchasers of a product sold exclusively within a single state may come from another state and/or transport said product across state lines may not be relied on by an applicant for registration to satisfy the ‘use in commerce’ requirement of the statute.” *In re Cook, United, Inc.*, 188 U.S.P.Q. (BNA) 284, 282 (TTAB 1975) (citing *In re Bagel Factory*, 183 U.S.P.Q. (BNA) 553, 554-555 (TTAB 1974)) (“transportation” of goods by purchasers after intrastate retail sale is not “transportation” for purposes of satisfying “use in commerce” requirement).

Citing *In re Gastown*, 326 F.2d 780, 140 U.S.P.Q. (BNA) 216 (CCPA 1964), *Cook* acknowledged that a more flexible standard applies to use of service marks where the services are rendered at or near interstate highways or other places which are likely to serve interstate travelers. The rule has been and continues to be that services may be rendered in “interstate commerce” even if rendered from one location in a single state. But with respect to goods (not services), the statute “is clear and has been given a consistent interpretation”. *Cook, United*, 188 U.S.P.Q. at 285. The rule was, and remains today, that the sale of *goods* manufactured and sold

to customers entirely intrastate does not qualify as “use in commerce” for purposes of the Lanham Act.

Count II of the Amended Petition for Cancellation alleged lack of use in interstate commerce and sought cancellation on this ground. Respondent’s discovery responses make out a *prima facie* case of lack of use in commerce, and Respondent has come forth with no evidence to rebut it. Respondent’s Registration should be cancelled for failure to have met the statutory requirement of “use in commerce” required by Section 1 of the Lanham Act, 15 U.S.C. §1051.

C. Respondent Has Never Used His Mark for Clocks, Jewelry or Jewelry Clocks

When Respondent filed his application for registration, he swore under penalty of perjury that his mark was then in use in commerce not only on watches but on “clocks” and “jewellery [sic].” These claims were false.

Respondent has unqualifiedly admitted that he has never used THE CAPE COD WATCH on clocks, either before or after he filed his application. (Responses to RFAs 10, 13). As for jewelry, Respondent justifies this claim only on the ground that he considers his watches to be a “species of jewelry” (*id.* 8). As set forth in footnote 3, *supra*, this after-the-fact justification is bogus. Simply put, watches and jewelry are two separate types of goods, both in common language and PTO practice. A person selling watches is not entitled to a registration for “jewelry and watches.”

While Petitioner believes that these claims of rights in clocks and jewelry were clearly made with an intent to deceive the PTO into granting a registration of a broader scope than his use would justify, Petitioner acknowledges that the record does not show an intent to deceive by “clear and convincing evidence.” Therefore, under the high standard of proof set forth in *In re Bose Corp.*, 580 F.3d 1240, 91 U.S.P.Q.2d 1938, 1939 (Fed. Cir. 2009), Petitioner cannot contend that the registration should be cancelled in its entirety due to fraud.

However, in the unlikely event that Respondent's Registration is not cancelled on one of the other two grounds set forth above, this Board should exercise its authority under Section 18 of the Lanham Act to cancel the registration in part so as to delete all goods other than watches, watch bracelets and "jewelry watches".

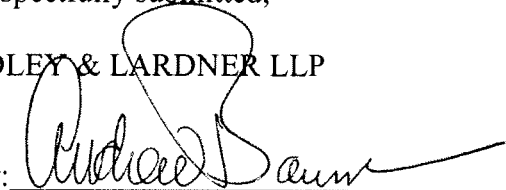
V. CONCLUSION

Respondent's Registration should never have been issued. The conflict between Registrant's Registration for CAPE COD 2 ZONES for watches and respondent's mark CAPE COD WATCH for identical goods is clear and obvious. Further, the record is clear that respondent's use of the mark was wholly intrastate both before and after the filing of the application. This Board should rectify this erroneous issuance of registration by cancelling it.

Respectfully submitted,

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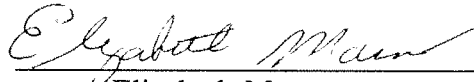
Dated: New York, New York
March 20, 2012

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **BRIEF FOR PETITIONER** was served via email on Registrant by forwarding copies to his counsel as follows:

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Date: March 20, 2012


Elizabeth Marmo

**THIS OPINION IS NOT A
PRECEDENT OF
THE T.T.A.B.**

Hearing: April 19, 2011 Mailed: November 16, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re *Midwestern Pet Foods, Inc.*

Serial No. 77327252

Timothy D. Pecsénye of Blank Rome LLP for *Midwestern Pet Foods, Inc.*

Priscilla Milton, Trademark Examining Attorney, Law Office 110 (Chris A.F. Pedersen, Managing Attorney).

Before Holtzman, Cataldo and Wolfson,
Administrative Trademark Judges.

Opinion by Cataldo, Administrative Trademark Judge:

An application was filed by *Midwestern Pet Foods, Inc.* to register in standard characters on the Principal Register the mark KITTY NIBBLES for "cat treats" in International Class 31.¹

¹ Application Serial No. 77327252 was filed on November 12, 2007, based upon applicant's assertion of its bona fide intent to use the mark in commerce on the goods. In response to a requirement by the examining attorney, applicant disclaimed KITTY apart from the mark as shown.

The trademark examining attorney refused registration under Section 2(d) of the Trademark Act on the ground that applicant's mark, as used on or in connection with its goods, so resembles the mark shown below, previously registered on the Principal Register for "cat food and cat treats" in International Class 31,² as to be likely to cause confusion.



When the refusal was made final, applicant appealed. Applicant and the examining attorney filed main briefs on the issue under appeal and applicant filed a reply brief. In addition, applicant and the examining attorney presented arguments before the Board in an oral hearing held on April 19, 2011.³

Timeliness of Examining Attorney's Brief

In its reply brief, applicant argues that

...Applicant's Brief was mailed to the Examining Attorney April 2, 2010. While no brief was filed within the sixty day time period, on June 28, 2010, the Board re-sent Applicant's Brief allowing

² Registration No. 3418325 issued on April 29, 2008 with a disclaimer of KITTEN apart from the mark as shown. Color is not claimed as a feature of the mark.

³ Applicant's resubmission, at the Board's invitation, of evidence consisting of Exhibit 3 to its request for reconsideration of the final refusal is noted.

the Examining Attorney an additional sixty days to file a brief explaining only that the earlier brief was not received by the Examining Attorney. The June 28, 2010 notice does not state that Applicant's Brief was not mailed, which it presumably was, only that it was brought to the Board's Attention that it was not received. Further, the Examining attorney does not explain why her Brief was late filed when it was ultimately submitted August 19, 2010. Certainly Applicant would not be allowed extra time to submit a filing simply by claiming a filing, presumably mailed, was not received. As such, Applicant respectfully requests that the Board exclude the Examining Attorney's Brief as no adequate explanation has been provided to explain the late filing.

A review of the relevant procedural history of the instant appeal is helpful in determining applicant's request:

- the Board issued a paralegal order on January 22, 2010, allowing applicant 60 days in which to submit its brief on appeal;
- applicant submitted its main brief on appeal on March 23, 2010;
- the Board issued a paralegal order on April 2, 2010 forwarding the electronic record of the application file to the examining attorney and allowing the examining attorney 60 days within which to submit her brief on appeal;
- the Board issued a subsequent paralegal order on June 28, 2010 noting that, due to an inadvertence, the examining attorney did not receive a copy of applicant's March 23, 2010 appeal brief and allowed

the examining attorney an additional sixty days in which to submit her brief on appeal;

- the examining attorney submitted her brief on August 19, 2010.

Thus, it is clear that in the June 28, 2010 order, the Board reset the examining attorney's time in which to submit her brief on appeal. While the June 28, 2010 order does not discuss the nature of the inadvertence resulting in the examining attorney's non-receipt of applicant's brief, neither does the order require the examining attorney to provide an explanation therefor. In short, the Board simply reset the examining attorney's time in which to submit her brief without requiring a showing of good cause therefor. In accordance with Trademark Rule 2.142(b), the examining attorney timely submitted her brief on August 19, 2010, within the 60 day time period as reset. In view thereof, applicant's request to strike the examining attorney's brief on appeal is denied.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d

1357, 177 USPQ 563, 567 (CCPA 1973). See also *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key, though not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 27 (CCPA 1976). See also *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997).

The Goods

We first compare applicant's goods with those of registrant. In making our determination under the second *du Pont* factor, we look to the goods as identified in the involved application and cited registration. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed."). See also *Paula Payne*

Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

In this case, applicant's goods are "cat treats" and registrant's goods are "cat food and cat treats." Thus, registrant's goods encompass and otherwise are identical in part to applicant's goods. In addition, we find that registrant's "cat food" would appear on its face to be related to "cat treats" inasmuch as both are commonly purchased by cat owners and fed to their pet cats. We further note that applicant does not argue that the goods are unrelated.

Channels of Trade

When identical goods are recited in an application and registration with no limitations as to their channels of trade or classes of consumers, such channels of trade and classes of consumers must be considered to be legally identical. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through

the same channels of trade."); and *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers.").

In the present case, registrant's goods encompass those of applicant and neither identification recites any limitations regarding the trade channels therefor. Accordingly, the trade channels are presumed to be identical, and applicant does not argue otherwise.

We turn then to our consideration of the marks at issue, noting initially that, "[w]hen marks would appear on virtually identical ... [goods or] services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." See *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698 (Fed. Cir. 1992), cert. denied, 506 U.S. 1034 (1994). See also *ECI Division of E-Systems, Inc. v. Environmental Communications Inc.*, 207 USPQ 443, 449 (TTAB 1980).

The Marks

Under the first *du Pont* factor, we must determine whether applicant's mark and registrant's mark are similar or dissimilar when viewed in their entirety in terms of appearance, sound, connotation and overall commercial

impression. See *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). We note initially that the test under the first *du Pont* factor is not whether the marks can be distinguished when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods or services offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). We further note that under actual marketing conditions, consumers do not necessarily have the luxury of making side-by-side comparisons between marks, and must rely upon their imperfect recollections. See *Dassler KG v. Roller Derby Skate Corp.*, 206 USPQ 255, 259 (TTAB 1980).

In this case, applicant's mark, KITTY NIBBLES, is similar to the registered mark shown below



in that they contain the highly similar terms KITTY versus KITTEN and the identical term NIBBLES. The examining attorney made of record the following definition of KITTY: "a cat, especially a kitten."⁴ As a result, we find that the word portion of registrant's mark, i.e. KITTEN LI'L NIBBLES, is highly similar to applicant's mark, KITTY NIBBLES, in appearance, sound and meaning.

Further, the design of a kitten or cat holding what appear to be cat treats in its paws, while visually prominent, is hardly the dominant feature of registrant's mark. The kitten design is somewhat smaller than the wording KITTEN LI'L NIBBLES in registrant's mark, and the wording and design are positioned next to each other such that the words appear to the left of the design. Such positioning of the kitten appears to visually reinforce the wording KITTEN LI'L NIBBLES. Indeed, it is very difficult to view the design without also viewing the words comprising the mark.

We find, therefore, that the wording KITTEN LI'L NIBBLES is the most visually prominent portion of registrant's mark, and accordingly it is entitled to more weight in our analysis. It is a well-established principle

⁴ The American Heritage Dictionary of the English Language (2000) retrieved from www.bartelby.com.

that, in articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on a consideration of the marks in their entireties. *See In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). Further, when a mark comprises both a word and a design, then the word is normally accorded greater weight because it would be used by purchasers to request the goods or services. *See In re Appetito Provisions Co.*, 3 USPQ2d 1553 (TTAB 1987). The presence of the kitten design in registrant's mark, particularly inasmuch as it is positioned next to and overlapping the words KITTEN LI'L NIBBLES, is insufficient to create a commercial impression that is separate from that of applicant's KITTY NIBBLES mark.

We are not persuaded by applicant's argument that its mark connotes small snacks, or nibbles, for cats while registrant's mark connotes a character called Kitten Li'l. In that regard, we note that registrant's mark may likewise connote small, or "Li'l" nibbles. Applicant further has introduced evidence that registrant's advertisements and packaging for its goods under its mark refer to a character

named Kitten Li'l. Nonetheless, our determination of the similarities or dissimilarities between the marks is based upon the applied-for and registered marks themselves, not evidence of the context in which the marks are used. As a result, such evidence fails to support its rather speculative contention regarding the manner in which consumers will perceive registrant's mark in connection with its recited goods.

Based upon the above analysis, we find that when the marks KITTY NIBBLES and KITTEN LI'L NIBBLES and design are viewed in their entirety, the similarities in appearance, sound, connotation and commercial impression outweigh the differences. See *Palm Bay Imports, Inc. v. Veuve Clicquot*, *supra*.

Strength of the Registered Mark

In making our finding, we have considered applicant's evidence and argument that both KITTEN and NIBBLES are weak in the field of cat food and cat treats. In support of this argument, applicant submitted nine live third-party registrations containing the term NIBBLE or a derivation thereof.⁵ Registrations are not evidence of use of the

⁵ Two of the submitted registrations are cancelled. A cancelled registration is not evidence of anything except that it issued. See TBMP §704.03(b) (3d ed. 2011) and cases cited therein. See also *Time Warner Entertainment Co. v. Jones*, 65 USPQ2d 1650 (TTAB 2002). Any benefits conferred by the registration, including the

marks shown therein; thus, they are not proof that consumers are familiar with such marks so as to be accustomed to the existence of the same or similar marks in the marketplace. See *Smith Bros. Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973); *AMF Inc. v. Am. Leisure Products, Inc.*, 474 F.2d 1407, 177 USPQ 268 (CCPA 1973); and *Richardson-Vicks, Inc. v. Franklin Mint Corp.*, 216 USPQ 989 (TTAB 1982). However, these registrations, similar to a dictionary definition, may be used to demonstrate that a particular term has some significance in an industry. In *re Box Solutions Corp.*, 79 USPQ2d 1953, 1955 (TTAB 2006) ("[T]hird-party registrations can be used in the manner of a dictionary definition to illustrate how a term is perceived in the trade or industry"). See also *In re J.M. Originals Inc.*, 6 USPQ2d 1393, 1394 (TTAB 1987) ("[T]hird party registrations are of use only if they tend to demonstrate that a mark or a portion thereof is suggestive or descriptive of certain goods and hence is entitled to a narrow scope of protection").

evidentiary presumptions afforded by Section 7(b) of the Trademark Act were lost when the registration expired. See, e.g., *Anderson, Clayton & Co. v. Krier*, 478 F.2d 1246, 178 USPQ 46 (CCPA 1973).

Applicant also submitted evidence in the form of web pages from 8 different third-party websites in which various pet products identified in part by the term NIBBLES are displayed. However, the probative value of this evidence also is limited because applicant presented no evidence concerning the extent to which these third-party designations are used in commerce. For example, it is not known how frequently these websites are viewed or how broad the consumer base is for these goods. As a result, this record simply does not establish that NIBBLES has been severely diluted in the field of cat treats. *See Broadway Chicken, Inc.*, 38 USPQ2d 1559 (TTAB 1996) (BROADWAY weak for restaurant services based on evidence that *hundreds of* restaurants and eating establishments use that word). Thus, while it is clear that the term KITTEN is descriptive and NIBBLES is suggestive of the goods in registrant's mark, applicant's evidence does not establish that there is widespread use of similar marks for cat treats or cat food such that registrant's marks is weak and entitled to only a narrow scope of protection.

In any event, even if we were to find, based on applicant's evidence, that registrant's mark is weak and entitled to a narrow scope of protection, the scope is still broad enough to prevent the registration of a highly

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similar mark for identical or closely related goods. See *In re Farah Mfg. Co., Inc.*, 435 F.2d 594, 168 USPQ 277, 278 (CCPA 1971).

Summary

We have carefully considered the arguments and evidence submitted by applicant and the examining attorney, including all evidence not specifically discussed in this decision. In view thereof, we conclude that consumers familiar with registrant's goods sold under its above-referenced mark would be likely to believe, upon encountering applicant's goods rendered under its mark that the goods originated with or are associated with or sponsored by the same entity.

Decision: The refusal of registration is affirmed.

THIS OPINION
IS NOT A PRECEDENT
OF THE TTAB

Mailed:
November 22, 2011

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Sherwood Development Group LLC

Serial No. 77784128

Mark S. Bicks of Roylance, Abrams, Berdo & Goodman LLP for
Sherwood Development Group LLC.

Ada P. Han, Trademark Examining Attorney, Law Office 106
(Mary I. Sparrow, Managing Attorney).

Before Bucher, Wellington, and Kuczma,
Administrative Trademark Judges.

Opinion by Wellington, Administrative Trademark Judge:

Sherwood Development Group LLC, applicant, filed an
application to register the mark NOURISH KIDS (in standard
character form) on the Principal Register for goods
ultimately identified as:

Frozen, prepared or packaged meals consisting
primarily of meat, fish, poultry, vegetables,
processed fruit, and cheese and cracker combinations;
food package combinations consisting primarily of
dairy-based snack foods excluding ice cream, ice milk
and frozen yogurt; yogurt drinks in International
Class 29; and

Frozen, prepared or packaged meals consisting primarily of pasta or rice; food package combinations consisting primarily of bread, crackers and/or cookies; snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn in International Class 30.¹

The examining attorney has refused registration of applicant's mark pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark is likely to be confused with the previously registered mark NOURISH (in typed characters) that is the subject of two registrations (owned by the same entity) for the following goods:

Breakfast, lunch and dinner entrees, and snacks containing meat, fish and poultry, eggs, milk and milk products, namely, cream cheese spread, cheese spread, cottage cheese, sour cream used in conjunction with a weight management program, dried and cooked fruits and vegetables, jellies, sauces, namely, applesauce, snack dips and soups; protein based nutrient-dense snack bars in International Class 29;² and

Milkshakes and puddings used in conjunction with a weight management program, breakfast, lunch, dinner entrees, snacks and desserts, namely, cereals, cereal bars, namely, ready to eat, cereal derived food bars, muffins, breads, dessert bars, namely, brownies, coffee flavored dessert bars, chocolate crunch bars, peanut butter, caramel and mint chewy chocolate bars, fruit bars, nut bars, rice, sauces, namely, salsas and tomato sauces, gravies, salad dressings, frozen bars and ices, namely fudge bars, creamsicles and ice pops, food beverages with a coffee, tea or cocoa base, namely, coffee based beverages containing milk, cocoa

¹ Application Serial No. 77784128 is an intent-to-use application filed under Section 1(b) of the Trademark Act.

² Registration No. 3261204 issued July 10, 2007.

based beverages containing milk, iced teas in International Class 30.³

Registration has also been finally refused pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. §1056(a), based on applicant's failure to comply with the requirement to disclaim the word KIDS because the term is merely descriptive of applicant's goods within the meaning of Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1).

Applicant appealed the final refusals. Briefs were filed, including a reply brief from applicant. For the following reasons, we affirm the refusals to register.

Likelihood of Confusion

Our determination of the issue of likelihood of confusion is based on an analysis of all of the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Co., Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, however, two key, although not exclusive, considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods*,

³ Registration No. 3261209 issued July 10, 2007.

Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24 (CCPA 1976).

We first consider the *du Pont* factors regarding the goods, trade channels and classes of purchasers. In an *ex parte* appeal, likelihood of confusion is determined on the basis of the goods as they are identified in the application and the cited registration(s). *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); *In re William Hodges & Co., Inc.*, 190 USPQ 47, 48 (TTAB 1976).

Applicant's and registrant's goods in International Class 29 are legally identical, in part, because applicant's "frozen, prepared or packaged meals" are essentially the same as, and are encompassed by, registrant's "breakfast, lunch and dinner entrees." Both applicant's meals and registrant's entrees are identified as consisting primarily of "meat, fish and poultry." Registrant's identification of goods is not limited to the manner in which its entrees will be prepared and thus may be "frozen, prepared and packaged" in the same manner as applicant's meals. Likewise, applicant's "food package combinations consisting primarily of dairy-based snacks" is broad enough to include registrant's "milk products,

namely, cream cheese spread, cheese spread, cottage cheese, sour cream used in conjunction with a weight management program." The primary ingredients of applicant's food package combinations are dairy-based snacks and may include many of the same dairy-based items listed in the registration.

As to International Class 30, applicant's "food package combinations consisting primarily of bread, crackers and/or cookies" are closely related, if not identical, to registrant's "cereal derived food bars, muffins, breads, dessert bars, namely, brownies, coffee flavored dessert bars, chocolate crunch bars, peanut butter, caramel and mint chewy chocolate bars, fruit bars, [and] nut bars." (The underlining is added for emphasis to underscore potentially identical goods). We further note that registrant prefaces certain goods in International Class 30 as "snacks and desserts" and the application lists a "snack mix consisting primarily of crackers, pretzels, candied nuts and/or popped popcorn."

We conclude that the application lists certain food products in International Class 29 that are identical to those identified in one of the two cited registrations. With respect to International Class 30, the applicant has some food products that are very closely related, if not

identical, to those identified in the other cited registration. Accordingly, this factor therefore weighs strongly in favor of finding a likelihood of confusion.

Because the goods in the application and the cited registrations are, in part, identical, we must presume that the channels of trade and classes of purchasers at least in part are the same. *Genesco Inc. v. Martz*, 66 USPQ2d 1260, 1268 (TTAB 2003) ("Given the in-part identical and in-part related nature of the parties' goods, and the lack of any restrictions in the identifications thereof as to trade channels and purchasers, these clothing items could be offered and sold to the same classes of purchasers through the same channels of trade"); *In re Smith and Mehaffey*, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers"). Even where the goods are not identical, they are very closely related food items and the common trade channels for these goods will be the same. For example, registrant's and applicant's goods, such as snack foods, desserts, cookies, etc., will be found in the same sections of the same grocery stores. Likewise, the classes of purchasers for these goods will also be the same, including the ordinary consumer exercising an ordinary amount of

care. To the extent that the registrant's goods may be directed to consumers interested in weight management or nutritionally balanced food items, we note that applicant's identification of goods does not contain any restrictions thereto and thus may also be geared to the same consumers with similar interests. Thus, the *du Pont* factors involving trade channels and classes of purchasers also favor a finding of likelihood of confusion.

This brings us to the similarity of the marks. We keep in mind that when marks would appear on identical goods, as they partially do here, the degree of similarity necessary to support a conclusion of likely confusion declines with respect to that class of goods (in this case, International Class 30). *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992). Our focus is on whether the marks are similar in sound, appearance, meaning, and commercial impression. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 73 USPQ2d 1689 (Fed. Cir. 2005). In articulating reasons for reaching a conclusion on the issue of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate

conclusion rests on a consideration of the marks in their entireties. *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749, 751 (Fed. Cir. 1985). For example, merely descriptive matter may be accorded subordinate status relative to the more distinctive portions of a mark. *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997).

Here, applicant has adopted the registered mark, NOURISH, and added the term KIDS. As a result, the essence of this appeal is a disagreement between applicant and the examining attorney regarding whether the addition of the term sufficiently distinguishes applicant's proposed mark, NOURISH KIDS, from the registered mark, NOURISH.

Applicant contends that the common element, NOURISH, is so suggestively weak in connection with food products that the addition of KIDS is sufficient for purposes of distinguishing the two marks. In support, applicant submitted copies of several third-party registrations and applications for marks that contain the term NOURISH and cover food-related goods or services. Applicant argues that in view of the weakness of NOURISH, it is the latter element KIDS that dominates its mark in terms of the commercial impression of the entire mark. Applicant argues that KIDS is not descriptive but only "suggestive" and, in

traversing the disclaimer requirement, argues that "mature thought and imagination and multi-step reasoning are necessary to make a connection between the meaning of NOURISH KIDS and the nature of applicant's goods." Brief, p. 13. In support of this latter point, applicant has submitted copies of third-party registrations and published applications for marks containing the term KIDS without a disclaimer thereof and covering food products. Ultimately, applicant urges the term KIDS should not be disclaimed and its mark as a whole is distinguishable from the registered mark.

The examining attorney responds in her brief that she "does not disagree that the term 'NOURISH' is weak and diluted on the trademark register for food related goods and services." Brief, p. 9. However, she takes issue with the significance of the third-party registrations and applications because they are not evidence of actual use in commerce. She also asserts that even weak marks are entitled to protection and applicant has "simply added the merely descriptive term 'KIDS' to the cited mark." Id. at p. 10. In support of this argument, and her disclaimer requirement, she submitted the dictionary definition of the term "kids," - "a young person; especially: CHILD - often used as a generalized reference to one especially younger

or less experienced..."⁴ In the context of applicant's goods and the mark as a whole, she argues that "kids" is "synonymous with 'children,' [and] merely describes features of applicant's food goods. Kids are the target consumer, the very individuals who will eat the products." Id. at p. 13. The examining attorney has also supplied copies of registrations containing a disclaimer of the term KIDS and covering food products.

In determining degree of similarity between the marks, we initially address the significance of the term KIDS. Based on the record, we agree with the examining attorney that KIDS is merely descriptive of applicant's identified goods because it informs the consumer that the food items are intended for consumption by children, *e.g.*, in terms of portion-size, nutritional value, etc. The term is defined as being synonymous with "children" and the examining attorney has provided printouts from third-party websites indicating that the nutritional intake of "kids" is a matter of concern.⁵ Thus, consumers encountering applicant's food products will understand the term KIDS as

⁴ Merriam-Webster Online Dictionary. Printout attached to September 13, 2009 office action.

⁵ Attached to September 13, 2009 office action.

indicating that the food products are intended for children.

As to the dueling third-party registrations and applications where a disclaimer of KIDS was or was not required, these may be used as evidence, albeit not conclusive, of whether the term is descriptive. See, e.g., *Sweats Fashions, Inc. v. Pannill Knitting Co.*, 833 F.2d 1560, 4 USPQ2d 1793, 1797 n.1 (Fed. Cir. 1987). In this regard, the third-party registrations submitted by the examining attorney far outnumber those submitted by applicant. Moreover, with regard to many of the registrations submitted by applicant, the absence of a disclaimer of the term KID or KIDS may be readily explained based on USPTO examination policy to not require a disclaimer if an otherwise descriptive term is employed in a unitary fashion with other elements in the mark such that the mark as whole creates a commercial impression that is not descriptive and thus registrable. See Trademark Manual of Examining Procedure (TMEP) § 1213.05(a)-(g) ("Unitary Marks") (8th Ed. rev. October 2011). For example, in contrast to applicant's mark, the term KID is used in a unitary fashion in the following third-party registered

marks submitted by applicant: CAN DO KID (Reg. No. 3633112), CAP'N KID (Reg. No. 2942175), and the stylized mark at right (Reg. No. 2827226).



In view of the descriptive nature of the term KIDS, it must be disclaimed and, for purposes of determining the mark's overall commercial impression, it is less likely to be perceived as having source identifying significance. *In re Dixie Restaurants Inc.*, 41 USPQ2d 1534. In other words, consumers viewing the mark NOURISH KIDS in connection with applicant's food products are likely to understand the term KIDS as merely describing a feature of applicant's food products, *i.e.*, they are intended for children's consumption; the same consumers will focus more attention on the initial, non-descriptive element, NOURISH. In addition, because the term NOURISH appears first, it is even more likely to be impressed upon the mind of a purchaser and will be remembered and used when calling for the goods. *See Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988). Indeed, consumers who are already familiar with registrant's use of the NOURISH on food products and encounter applicant's NOURISH KIDS mark on the same type of goods may mistakenly believe that the latter is simply an additional line of

registrant's goods designed or being touted for consumption by children.

As to applicant's argument that the registered mark NOURISH is "weak" and "diluted" and thus should be accorded a narrow scope of protection, we note that the two cited registrations are on the Principal register and must therefore be presumed valid and not descriptive. Trademark Act Section 7(b). In addition, the record is devoid of evidence showing any actual third-party use of marks containing the term NOURISH. Rather, as support for its contention that NOURISH is weak, applicant relies on four third-party registrations and on an application for marks containing the term NOURISH and covering food and/or beverages. The pending application has "no probative value other than as evidence that the application was filed" and has not been further considered. *Edwards Lifesciences Corp. v. Vigilanz Corp.*, 94 USPQ2d 1399, 1403 n.4 (TTAB 2010), citing, *In re Phillips Van Heusen Corp.*, 63 USPQ2d 1047, 1049 n.4 (TTAB 2002). We note that several of the registered marks employ the term NOURISH in a much longer phrase, e.g., NOURISH YOUR BODY AND MIND (Reg. No. 296588) and NOURISH ALL AREAS OF YOUR LIFE (Reg. No. 2784863). Nevertheless, in conjunction with the defined meaning of

the term,⁶ we find that the term NOURISH has some suggestive connotation when used in connection with food products.

Although the registered mark NOURISH may be suggestive of food products, we disagree with applicant that the addition of the descriptive term KIDS suffices for purposes of distinguishing the marks, especially when considering that the two marks will be used on identical or closely related food products. Even allowing for some weakness of the registered mark, the marks remain confusingly similar. We have long held that even weak marks are entitled to protection against registration of similar marks for closely related goods and/or services. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974).

Applicant, in its brief, repeatedly cites to two Board decisions in support of its argument that the marks NOURISH and NOURISH KIDS are not confusingly similar; however, the circumstances surrounding the marks in the cited decisions are significantly different from this proceeding. In *Rocket Trademarks Pty Ltd. v Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011), the Board found the mark ZU ELEMENTS

⁶ Defined as "to provide with food or other substances necessary for life and growth." *The American Heritage Dictionary of the English Language* (4th Ed. 2000). The Board may take judicial notice of dictionary definitions. *University of Notre Dame du*

(stylized) was not confusingly similar to ELEMENTS on identical clothing goods because the additional term, ZU, appeared first in the applicant's mark in a more prominent manner (it appeared in a larger font) and was arbitrary in connection with the goods. Likewise, in *Knight Textile Corp. v. Jones Investment Co.*, 75 USPQ 1313 (TTAB 2005), the Board found applicant's mark NORTON MCNAUGHTON ESSENTIALS not to be confusingly similar to opposer's mark ESSENTIALS, despite both marks being used on identical clothing goods. The Board based the decision on findings that the registered mark was highly suggestive of clothing and applicant's addition of its house mark was significant because it comprised a combination of arbitrary terms appearing first in the mark.

The facts before us in this matter are clearly distinguishable from those in *Rocket Trademarks* and *Knight Textile*. Here, applicant has merely added a descriptive term, as opposed to an arbitrary one, to a registered mark and seeks to register this proposed mark for identical and closely related goods. Moreover, in the two prior Board proceedings, the Board concluded that the registered marks, ELEMENTS and ESSENTIALS respectively, were highly

Lac v. J. C. Gourmet Food Imports Co., Inc., 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

suggestive terms in connection with relevant goods. Here, the record does not show that the term NOURISH is so highly suggestive.

When we consider the record and all relevant likelihood of confusion factors, we conclude that, when purchasers of registrant's and applicant's goods encounter the marks NOURISH and NOURISH KIDS, respectively, for the goods, they are likely to believe that the sources of these goods are in some way related or associated. As a result, there is a likelihood of confusion.

Disclaimer

An examining attorney may require an applicant to disclaim an unregistrable component of a mark otherwise registrable. Trademark Act Section 6(a). Merely descriptive terms are unregistrable, under Trademark Act Section 2(e)(1) and, therefore, are subject to disclaimer if the mark is otherwise registrable. Failure to comply with a disclaimer requirement is grounds for refusal of registration. See *In re Omaha National Corp.*, 819 F.2d 1117, 2 USPQ2d 1859 (Fed. Cir. 1987); *In re Richardson Ink Co.*, 511 F.2d 559, 185 USPQ 46 (CCPA 1975); *In re National Presto Industries, Inc.*, 197 USPQ 188 (TTAB 1977); and *In re Pendleton Tool Industries, Inc.*, 157 USPQ 114 (TTAB 1968).

A term is deemed to be merely descriptive of goods or services, within the meaning of Section 2(e)(1), if it forthwith conveys an immediate idea of an ingredient, quality, characteristic, feature, function, purpose or use of the goods or services. See, e.g., *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987), and *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978). A term need not immediately convey an idea of each and every specific feature of the applicant's goods or services in order to be considered merely descriptive; it is enough that the term describes one significant attribute, function or property of the goods or services. See *In re H.U.D.D.L.E.*, 216 USPQ 358 (TTAB 1982); *In re MBAssociates*, 180 USPQ 338 (TTAB 1973).

Whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services, and the possible significance that the term would have to the average purchaser of the goods or services because of the manner of its use. That a term may have other meanings in different contexts is not controlling. *In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979). Finally, "[a] mark can be descriptive if it describes the

intended users of the goods or services." *In re Planalytics, Inc.*, 70 USPQ2d 1453, 1454 (TTAB 2004).

With the above principles in mind and for reasons previously explained in this decision's likelihood of confusion discussion regarding the similarity of the marks, the term KIDS is merely descriptive as used in applicant's proposed mark and on the identified goods. Upon viewing the proposed mark on applicant's identified food products, consumers will immediately understand the term KIDS as describing a key feature of those goods, *i.e.*, that the food products are intended for consumption by children.

We disagree with applicant's argument that "the consumer would have to change or include the words NOURISH **FOR KIDS** or more accurately **NOURISHMENT FOR YOUR KIDS** or even **NOURISHMENT FOR YOU TO BUY FOR YOUR KIDS** or more appropriately, **NOURISHMENT FOR PARENTS OR GUARDIANS TO BUY AND PROVIDE TO KIDS** in order to immediately understand information concerning the Applicant's goods." Brief, pp. 13-14. (Boldness in original and used to emphasize additional words that applicant believes are necessary for the term KIDS to be found descriptive). Applicant apparently is under the mistaken impression that the mark must be grammatically correct and spell out to the consumer the exact nature of the goods in order for the term KIDS to

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be determined merely descriptive. However, the test for whether a term is descriptive is not whether the consumer can guess what are the goods based on the mark. Rather, our analysis is based on a consumer being confronted with the mark in the context of applicant's identified food products. With this in mind, we decide whether that same consumer will understand KIDS as describing a significant attribute, function or property of the food products. Again, we conclude that consumers will perceive this term as describing a key feature of the identified goods and, accordingly, must be disclaimed.

DECISION: The refusal to register the mark under Section 2(d) of the Trademark Act is affirmed. We further affirm the refusal to register based on applicant's failure to comply with the requirement to disclaim the word KIDS.